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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

02-161US02

Application Number

10/688,224

Filed

10/15/2003

First Named Inventor

Sharon Mi Lyn Tan

Art Unit

3763

Examiner

Laura A. Bouchelle

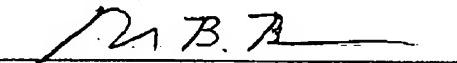
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor.

Signature

 assignee of record of the entire interest.See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

David B. Bonham

Typed or printed name

 attorney or agent of record.Registration number 34297

703-433-0510

Telephone number

 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

01/15/2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

*Total of 1 forms are submitted.

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Serial No.: 10/688,224

Reasons for Requesting Pre-Appellate Review

Page 1 of 3

Status of Claims

Claims 3-7, 13, 15-30, and 32-33 are presently pending. Claims 1-2, 8-12, 14, and 31 have been cancelled by Applicant. Claims 13 and 18-28 were previously withdrawn from consideration as belonging to a non-elected species.

Objection to Claims 9-11

Claims 9-11 were objected to in the final Office Action of September 15, 2008 as being dependent upon cancelled claim 8. Claims 9-11 were cancelled in the Applicant's response to the final Office Action, rendering this objection moot.

Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 9-11 were rejected in the final Office Action of September 15, 2008 under 35 U.S.C. 112, second paragraph, because there is no antecedent basis for the limitation "the substrate". Claims 9-11 were cancelled in the Applicant's response to the final Office Action, rendering this rejection moot.

Rejection Under 35 U.S.C. 102(b)

In the final Office Action of September 15, 2008, the Examiner rejected claims 3-7, 15-17, 29-30, and 32-33 as being anticipated by U.S. Pat. No. 5,562,652 (Davis). Applicant respectfully traverses the rejection and its accompanying remarks.

For a reference to anticipate a claim it must disclose each and every element of the claim. See MPEP 2131 and cases cited therein, particularly *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) and *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (Fed. Cir. 1978). The Davis reference fails as an anticipatory reference because it fails to teach all of the claimed elements of the present invention.

Claims 3-7, 29, 30 and 33

For example, independent claims 3 and 7 (and thus claims 4-6, 29, 30 and 33 depending therefrom) require (a) at least one active lumen within an outer wall and (b) a false lumen within an outer wall. The at least one active lumen partially surrounds the false lumen. This is neither taught nor suggested by Davis.

Serial No.: 10/688,224

Reasons for Requesting Pre-Appellate Review

Page 2 of 3

Davis includes (a) a closed reservoir 42 containing a water-activated antiseptic agent (which the Examiner is construing as a false lumen), a central lumen 14 (which the Examiner is construing as an active lumen) and an inflation passageway 24 (which the Examiner is also construing as an active lumen). Of the two active lumens 14 and 24, only the lumen 24 can be reasonably argued to be disposed within an outer wall as claimed. In claims 3 and 7, it is this active lumen 24 that must at least partially surround the false lumen 42, which is clearly not the case as seen from the Figures of Davis.

In the Advisory Action, the Examiner urges that Fig. 5 illustrates a configuration in which the active lumen 14 partially surrounds the false lumen 42. However, it is again noted that the active lumen 14 of Fig. 5 is not disposed *within an outer wall* as required by claims 3 and 7.

For at least the above reasons, withdrawal of the rejection of claims 3-7, 29, 30 and 33 under 35 U.S.C. 102(b) is requested.

Claims 15-17 and 32

On the other hand, independent claims 15 and 17 (and thus claims 16 and 32 depending therefrom) each requires comprise a portion that is partially insertable into the body of a patient and accessible from outside the body once the portion is inserted. The portion has, *inter alia*, an outer wall and a false lumen within the outer wall.

Claims 15 and 17 further require a substrate comprised of an anti-microbial agent and having first and second ends, which substrate is capable of being inserted into the false lumen. This feature is neither taught nor suggested by Davis. The closed reservoir 42 of Davis (which the Examiner is construing as a false lumen) is not adapted to receive an anti-microbial-agent containing substrate via insertion, for instance, because there is no opening that leads to the closed reservoir 42, through which a substrate might be inserted.

Moreover, claims 15 and 17 also require that the portion (which is partially insertable into the body of a patient and accessible from outside the body once the portion is inserted) have a first active lumen and a second active lumen, wherein the first active lumen and the second active lumen at least partially surround the false lumen (which is within the outer wall of the portion).

As noted above, Davis includes (a) a closed reservoir 42 containing a water-activated antiseptic agent (which the Examiner is construing as a false lumen), a central lumen 14 (which

Serial No.: 10/688,224

Reasons for Requesting Pre-Appellate Review

Page 3 of 3

the Examiner is construing as an active lumen), and an inflation passageway 24 (which the Examiner is also construing as an active lumen).

In the Advisory Action, the Examiner urges that Fig. 5 illustrates a configuration in which the active lumen 14 partially surrounds the false lumen 42. However, in claims 15 and 17, the active lumen 14 and the active lumen 24 must both at least partially surround the false lumen 42, which is clearly not the case.

For at least the above reasons, withdrawal of the rejection of claims 15-17 and 32 under 35 U.S.C. 102(b) is requested.